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The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

9
10 Ex parte HERVE BURGAUD,
11 RUI PEREIRA,
12 and BEATRICE BELCOUR-CASTRO
13

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15 Appeal 2009-001991
16 Application 10/611,968
17 Technology Center 1700
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20 Oral Hearing Held: April 21, 2009
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23 Before ADRIENE LEPIANE HANLON, JEFFREY T. SMITH, and
24 JEFFREY B. ROBERTSON, Administrative Patent Judges
25

26 ON BEHALF OF THE APPELLANT:

27 DEBORAH M. HERZFELD, ESQUIRE
28 Finnegan, Henderson, Farabow, Garrett &
29 Dunner, LLP
30 901 New York Avenue, N.W.
31 Washington, D.C. 20001-4413
32 (202) 408-4368
33 (202) 408-4400 - fax
34 deborah.herzfeld@finnegan.com
35

36 ALSO PRESENT:

37 KIMBERLY BRASLOW
38 CHANG DONG
39

1 The above-entitled matter came on for hearing on Tuesday,
2 April 21, 2009, commencing at 9:20 a.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown,
4 Notary Public.

5 THE USHER: Calendar Number 22, Appeal Number 2009-
6 1991. Ms. Herzfeld.

7 JUDGE HANLON: Good morning.

8 MS. HERZFELD: Good morning. How are you?

9 JUDGE HANLON: Good. Would you like to introduce who
10 you have with you?

11 MS. HERZFELD: Yes, please. With me today, Kimberly
12 Braslow is a student associate at my law firm, and Chang Dong, who is an
13 international guest at the law firm. She is the director of the Legal Office
14 Department at the Chinese State Intellectual Property Office, and she is
15 currently getting her LLM at American University.

16 JUDGE HANLON: Welcome.

17 MS. HERZFELD: Thank you.

18 JUDGE HANLON: You have 20 minutes. You can begin
19 whenever you're ready.

20 MS. HERZFELD: Thank you. My name is Deborah Herzfeld,
21 and I'm appearing for the Appellant in this case. I believe this should be a
22 very straightforward and quick argument.

23 As you know, the claims 1 through 6, 9 through 10, and 12
24 through 36 are rejected under 103 as being allegedly obvious over U.S.
25 Patent Application Publication Hoeffkes, et al., and Benshein as a secondary
26 reference. The Appellants' argument is that the Examiner has not

1 established a prima facie case of obviousness.

2 The Appellants' contention is that the Examiner's combination
3 requires too much picking and choosing. Hoeffkes teaches a dyeing
4 composition that requires a specific enzyme and a dye precursor. The
5 Examiner contends that Hoeffkes teaches a primary alcohol for an aldehyde
6 precursor as well as alcohol-reducing enzymes, but these teachings are
7 secondary considerations in the application.

8 There really isn't any motivation for combining these two
9 references because the Hoeffkes reference teaches a mechanism where a
10 phenol-oxidizing enzyme releases an oxygen which then oxidizes the dye
11 precursor.

12 Benshein, on the other hand, teaches a dye precursor that has to
13 react with the coupling agent before it is oxidized.

14 So there is no reason that one of ordinary skill in the art at the
15 time the invention was made would have looked at these two references and
16 been motivated to then pick and choose these various secondary elements to
17 arrive at the combination as claimed, which is an aldehyde precursor with an
18 enzyme to convert to an aldehyde, which then will react with the dye, the
19 heteroaromatic hydrazone.

20 The Examiner argues that the invention is directed to a dyeing
21 composition, which is not entirely true.

22 There are process claims that comprise the dye ingredients, talk
23 about the combined references and they are not -- the claims are not directed
24 to specific mechanical reactions, chemical reactions, and so that Appellants'
25 arguments are not relevant.

26 What appellant wants to reemphasize that these arguments are

1 being made for the purpose of showing why there is no motivation to look at
2 these two different chemical reactions and then arrive at the composition as
3 well as the processes claimed.

4 If you're looking for a composition that is going to have a
5 certain chemical reaction on the hair, you are going to need ingredients that
6 you know are going to cause that reaction and neither of the two cited
7 references discuss that type of reaction.

8 In addition, the Examiner suddenly at the end of his Answer
9 makes a statement saying he has a reason to believe the functional language
10 may be, in fact, an inherent characteristic of the prior art and attempts to
11 shift the burden onto the Appellants to prove the subject matter is not
12 inherent.

13 And the Appellants just want to note that that is obviously the
14 standard for inherency, that the Examiner has to show that certain results or
15 characteristics must occur and probabilities or possibilities are not sufficient
16 in showing inherency. That is MPEP section 2112.

17 So in conclusion, KSR does not overturn In re. Rouffett, which
18 still requires that the Examiner has to show reasons that the skilled artisan
19 confronted with the same problems as the inventor with no knowledge of the
20 claimed invention would select the elements from the cited art references for
21 combination in the manner claimed.

22 So the Examiner hasn't shown why someone -- how someone at
23 the time the invention was made, attempting to make a composition that
24 would react with aldehyde precursors on the hair with a dye precursor and
25 having this dye combination that can be in aqueous form as discussed in our
26 specification, would look to a reference discussing oxidizing reaction or

1 condensation reaction and then another reference that shows the dye
2 precursor has to be coupled before it can be oxidized.

3 There is just no basis there.

4 Do you have any questions for me?

5 JUDGE HANLON: Do you have any questions?

6 JUDGE SMITH: It appears that the Examiner is saying
7 regarding the composition of Hoeffkes that there reactions in addition to the
8 reaction of the phenol as a dye agent stated in the reference, that there is an
9 additional reaction that is occurring and your claim does not preclude that
10 additional reaction.

11 MS. HERZFELD: I mean -- but it is sort of what you would
12 say would be the reverse of what we've claimed. We have claimed that we
13 want a composition that will ensure that an aldehyde precursor reacts to
14 make an aldehyde that will react with the heteroaromatic hydrazone.

15 And what the Examiner is saying is this could possibly be going
16 on in the background while a dye precursor reacts with the oxygen released
17 from this oxidative enzyme.

18 JUDGE SMITH: Okay. But based on what, the Examiner is
19 saying that this reaction could also be present and your composition claims
20 do not exclude that from being present, that is another reaction also
21 occurring.

22 MS. HERZFELD: Correct. It doesn't exclude it.

23 JUDGE SMITH: Okay. But it is your position that the
24 Examiner has not shown that this secondary reaction is actually occurring in
25 the prior art?

26 MS. HERZFELD: Right. And more to the point that if this is

1 the -- if you're trying to create a composition that you know will have this
2 reaction on the hair, that really there was no motivation for you to have
3 looked at the disclosures of these two references to get you to an aldehydic
4 reaction because they are teaching oxidative condensation on the one hand
5 and then coupling and then oxidative condensation.

6 So there are two things going on there.

7 JUDGE SMITH: So it is your position that if the two different
8 references were combined, it is still a different reaction from what you're
9 claiming in your composition?

10 MS. HERZFELD: There is no guarantee that the reaction that
11 we're claiming or the composition we're claiming is going to be there.

12 JUDGE SMITH: Okay. I have no further questions.

13 JUDGE HANLON: Thank you.

14 Whereupon, the proceedings at 9:29 a.m. were concluded.